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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,942	12/12/2003	Tomomi Oshiba	KOT-0008-C	5721
23413	7590	07/12/2006	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	
DATE MAILED: 07/12/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/734,942

Examiner

Janis L. Dote

Applicant(s)

OSHIBA ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 25 February 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☒ C. Other see the attached.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: see the attached.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

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Attachment: Notice of NON-COMPLIANT AMENDMENT (37 CFR 1.121)

Only the corrected sections of the non-compliant amendment document must be resubmitted (in its entirety), in this case, the entire "Amendment to the specification" section and the entire "Amendment to the claims" section of applicants' amendment document filed on Feb. 25, 2005, must be resubmitted. 37 CFR 1.121(h).

The "Amendment to the specification" section filed on Feb. 25, 2005, does not comply with 37 CFR 1.121 for the following reason:

Item C: (1) The markings, i.e., the single brackets, used to indicate "deleted matter" in the amended paragraph bridging pages 5 and 6, the amended paragraph at page 8, "lines 12-14," the amended "full paragraph on page 8," the amended paragraphs bridging pages 10 and 11 and pages 11 and 12, the amended paragraph on page 15, lines 9-13, the amended paragraphs bridging pages 20 and 21 and bridging pages 33 and 34, the line on page 27, line 9, the amended first full paragraph on page 37, and amended Table 1, are not permitted under 37 CFR 1.121.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer

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consecutive characters . . ." (emphasis added).

(2) The second amended paragraph at page 2 of the "Amendment the specification" section is incorrectly characterized as replacing the paragraph on page 8, lines 12-14, of the specification. It should have been characterized as replacing the paragraph on page 8, "lines 12-24" (emphasis added).

37 CFR 1.121(b)(1) states that "[a]mendments to the specification . . . which are considered for amendment purposes to an amendment of a paragraph, must be made by submitting: (i) An instruction, which unambiguously identifies the location, to . . . replace a paragraph with one or more replacement paragraphs" (emphasis added).

(3) There are two versions of the amended first full paragraph on page 8. It is not clear which of these versions that applicants intend to replace the paragraph beginning at page 8, line 12, of the specification.

(4) The "Amendment to the specification" section replaces line 9 on page 27, of the specification, rather than replacing a paragraph or a section, e.g., the "Summary of the invention" section or the "Detailed description of the invention" section.

37 CFR 1.121(b) states that "[a]mendments to the specification . . . must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this

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section" (emphasis added).

(5) The "Amendment to the specification" section places quotes around the amended paragraphs presented on pages 2-4, 9, and 10 of the section without the proper markings to indicate their insertion.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text" (emphasis added).

The "Amendment to the claims" section filed on Feb. 25, 2005, does not comply with 37 CFR 1.121 for the following reasons:

Item E: The markings, i.e., the single brackets, used to indicate "deleted matter," e.g., "[wherein the toner contains an amount of]" in claim 1, in claims 1, 5, and 11 are not permitted under 37 CFR 1.121. This example is not exhaustive.

37 CFR 1.121 reads: "[W]hen claim text with markings is required. All claims being currently amended . . . shall . . . be submitted with markings to indicate changes that have been made relative to the immediate prior version of the claims. The text of any added subject must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets [i.e., [[]]] placed before and after the deleted characters may be used to show deletion of five or fewer consecutive letters" (emphasis added).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Jul. 3, 2006

Janis L. Dote
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PRIMARY EXAMINER
GROUP 1700
1700